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EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/029,458	Applicant(s) PARRY ET AL	
	Examiner CHAN S. PARK	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims are objected to because of the following informalities:

Claims 7, 8 and 10, line 1, "a protected document" should be -- the protected document --; and

Claim 15, line 1, "an untranslated document" should be -- the untranslated document --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites "the document has not been translated into a print ready format". However, claim 1 recites the method for "receiving a print ready version of the document from the computing device." It is confusing as to whether the document is in the print ready format when it is received from the computing device.

3. With respect to claim 33, arguments analogous to those presented for claim 4, are applicable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6, 8-10, 18-21, 25, 26, 34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurachi U.S. Patent No. 6,181,436.

4. With respect to claim 6, Kurachi teaches a method for facilitating secure printing (fig. 9), comprising the steps of:

receiving a protected document from a printing device (1d);

unprotecting the document (201h); and

transmitting the unprotected document back to the printing device so that the printing device can generate a hard copy of the document (1f & 3c-e).

5. With respect to claim 8, Kurachi teaches the method of claim 6, wherein the step of receiving the protected document comprises receiving an encrypted document (203k).

6. With respect to claim 9, Kurachi teaches the method of claim 8, wherein the step of unprotecting the document comprises decrypting the document (201h).

7. With respect to claim 10, Kurachi teaches the method of claim 6, wherein the step of receiving the protected document comprises receiving the protected,

untranslated document (201h). It is noted that translation/conversion is done at the printing device 3d.

8. With respect to claim 18, Kurachi teaches a method for facilitating secure printing (fig. 9), comprising the steps of:

receiving a document to be printed (3a);

determining that the document cannot be printed in its present form (col. 14, lines 37-41); and

receiving a communication from a computing device that contains information that would facilitate printing of the document (col. 21, lines 17-23).

9. With respect to claim 19, Kurachi teaches the method of claim 18, wherein the document is protected (col. 21, lines 17-23).

10. With respect to claim 20, Kurachi teaches the method of claim 19, wherein the document is encrypted (col. 21, lines 17-23).

11. With respect to claim 21, Kurachi teaches the method of claim 20, wherein the step of receiving a communication comprises receiving a key needed to decrypt the document (col. 21, lines 17-23).

12. With respect to claim 25, Kurachi discloses a computing device, comprising:
a processing device; and

memory including a security application that is configured to receive a protected document transmitted from a printing device, unprotect the document, and facilitate transmission of the unprotected document back to the printing device.

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13. With respect to claim 26, Kurachi discloses the computing device of claim 25, wherein the protected document is encrypted and the security application is configured to decrypt the encrypted document.

14. With respect to claim 34, Kurachi discloses a program stored on a computer-readable medium that facilitates secure printing, comprising:

logic configured to receive a protected document from a printing device;

logic configured to unprotect the document; and

logic configured to facilitate transmission of the unprotected document back to the printing device so that the printing device can generate a hard copy of the document.

15. With respect to claim 35, Kurachi discloses the program of claim 34, wherein the logic configured to unprotect the document comprises logic configured to decrypt the document.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi in view of Roberts et al. U.S. Patent No. 6,650,431 (hereinafter Roberts).

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16. With respect to claim 1, Kurachi teaches a method for facilitating secure printing, comprising the steps of:

receiving a document to be printed (3a);

determining that the document cannot be printed in its present form (col. 14, lines 37-41);

transmitting the document to a computing device (3h); and

translating the document into a print ready version at the printing device (3d).

Kurachi, however, does not teach whether the translating into the print ready version can be done at the computing device.

Roberts, the same field of endeavor of the document printing art, teaches the method for translating a document at a computing device (col. 10, lines 37-53).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the translating method of Roberts into the secure printing method of Kurachi.

The suggestion/motivation for doing so would have been obvious to facilitate the printing process by translating the document before it is transmitted to the computing device. It would eliminate the step of translating the document into the print ready format by the printing device.

Therefore, it would have been obvious to one of ordinary skill in the art to combine Kurachi with Roberts to obtain the invention as specified in claim 1.

17. With respect to claim 2, Kurachi teaches the method, wherein the document is protected document (201h).

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18. With respect to claim 3, Kurachi teaches the method, wherein the document is encrypted (201h).

19. With respect to claim 4, Roberts teaches the method, wherein the document has not been translated into a print ready format before it is transmitted to the printing device (col. 10, lines 37-53).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kurachi and Roberts as applied to claim 1 above, and further in view of Fresk et al. U.S. Patent No. 6,026,258 (hereinafter Fresk).

20. With respect to claim 5, the combination teaches the method of claim 1, but it does not teach expressly that the step of transmitting the document comprises wirelessly transmitting the document to a portable computer device.

Fresk, the same field of endeavor of the document printing art, teaches the method for communicating wirelessly between a printing device and a portable computer device (fig. 1).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the wireless communication of Fresk into the secure printing method of Kurachi and Roberts.

The suggestion/motivation for doing so would have been to provide the same secure printing method of Kurachi and Roberts in the portable computer device in a wireless communication setting.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 5.

Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi as applied to claim 6 above, and further in view of Fresk.

21. With respect to claim 7, Kurachi teaches the method of claim 6, but it does not teach expressly that the step of transmitting the document comprises wirelessly transmitting the document to a portable computer device.

Fresk, the same field of endeavor of the document printing art, teaches the method for communicating wirelessly between a printing device and a portable computer device (fig. 1).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the wireless communication of Fresk into the secure printing method of Kurachi.

The suggestion/motivation for doing so would have been to provide the same secure printing method of Kurachi in the portable computer device in a wireless communication setting.

Therefore, it would have been obvious to combine the three references to combine Kurachi with Fresk to obtain the invention as specified in claim 7.

22. With respect to claim 12, arguments analogous to those presented for claim 7, are applicable.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi as applied to claim 10 above, and further in view of Roberts.

23. With respect to claim 11, Kurachi teaches the method of claim 8, but it does not teach whether translating the document into a print ready format after unprotecting it.

Roberts, the same field of endeavor of the document printing art, teaches the method for translating a document at a computing device (col. 10, lines 37-53).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the translating method of Roberts into the secure printing method of Kurachi.

The suggestion/motivation for doing so would have been obvious to facilitate the printing process by both unprotecting and translating the document before it is transmitted to the computing device. It would eliminate the step of translating the document into the print ready format by the printing device.

Therefore, it would have been obvious to one of ordinary skill in the art to combine Kurachi with Roberts to obtain the invention as specified in claim 11.

Claims 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi in view of Roberts.

24. With respect to claim 13, arguments analogous to those presented for claims 6 and 11, are applicable.

25. With respect to claim 15, arguments analogous to those presented for claim 10, are applicable.

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26. With respect to claim 16, arguments analogous to those presented for claim 11, are applicable.

Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kurachi and Roberts as applied to claim 13 above, and further in view of Fresk.

27. With respect to claim 14, arguments analogous to those presented for claim 7, are applicable. Note that the three references are in the same field of endeavor which is the document printing art.

28. With respect to claim 17, arguments analogous to those presented for claim 12, are applicable.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi as applied to claim 18 above, and further in view of Fresk.

29. With respect to claim 22, arguments analogous to those presented for claim 7, are applicable.

Claims 23, 28, 29, 31-33, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi in view of Roberts.

30. With respect to claim 23, arguments analogous to those presented for claim 1, are applicable.

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31. With respect to claim 28, arguments analogous to those presented for claim 1, are applicable.
32. With respect to claim 29, refer to fig. 9 of Kurachi.
33. With respect to claim 31, arguments analogous to those presented for claim 1, are applicable.
34. With respect to claim 32, arguments analogous to those presented for claim 3, are applicable.
35. With respect to claim 33, arguments analogous to those presented for claim 4, are applicable.
36. With respect to claim 36, arguments analogous to those presented for claim 1, are applicable.
37. With respect to claim 37, refer to fig. 9 of Kurachi.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kurachi and Roberts as applied to claim 23 above, and further in view of Fresk.

38. With respect to claim 24, arguments analogous to those presented for claim 5, are applicable.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kurachi and Roberts as applied to claim 28 above, and further in view of Fresk.

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39. With respect to claim 30, arguments analogous to those presented for claim 5, are applicable.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi as applied to claim 25 above, and further in view of Fresk.

40. With respect to claim 27, arguments analogous to those presented for claim 7, are applicable.

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Contact Information


41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
October 28, 2005

Chan S. Park
Examiner
Art Unit 2622


EDWARD COLES
SUPERVISORY PATENT EXAMINER
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